

Robert N. Phillips (SBN 120970)
 REED SMITH LLP
 101 Second Street, Suite 1800
 San Francisco, CA 94105-3659
 Telephone: 415 543 8700
 Facsimile: 415 391 8269
 Email: robphillips@reedsmith.com

David H. Bernstein (*admitted pro hac vice*)
 Jyotin Hamid (*admitted pro hac vice*)
 Ashley E. Kelly (*admitted pro hac vice*)
 DEBEVOISE & PLIMPTON LLP
 919 Third Avenue
 New York, New York 10022
 Telephone: 212 909 6696
 Facsimile 212 521 7696
 Emails: dhbernstein@debevoise.com
 jhamid@debevoise.com
 aekelly@debevoise.com

Attorneys for Plaintiffs
 MARK ANTHONY INTERNATIONAL, SRL
 and AMERICAN VINTAGE BEVERAGE, INC.

Christopher C. Larkin (SBN 119950)
 SEYFARTH SHAW LLP
 2029 Century Park East, Suite 3500
 Los Angeles, California 90067-3021
 Telephone: (310) 277-7200
 Facsimile: (310) 201-5219
 Email: clarkin@seyfarth.com

D. Peter Harvey (SBN 55712)
 Matthew A. Stratton (SBN 254080)
 HARVEY SISKIND LLP
 Four Embarcadero Center, 39th Floor
 San Francisco, CA 94111
 Telephone: (415) 354-0100
 Facsimile: (415) 391-7124
 Emails: pharvey@harveysiskind.com
 mstratton@harveysiskind.com

Attorneys for Defendant
 JACK DANIEL'S PROPERTIES, INC.

**UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN FRANCISCO DIVISION**

MARK ANTHONY INTERNATIONAL,
 SRL, a Barbados corporation, and
 AMERICAN VINTAGE BEVERAGE, INC.,
 a Delaware corporation,

Plaintiffs and
 Counterclaim-Defendants,

v.

JACK DANIEL'S PROPERTIES, INC., a
 Delaware corporation,

Defendant and
 Counterclaim-Plaintiff.

Case No. C 12-2105 RS

**JOINT CASE MANAGEMENT
 STATEMENT**

1 Plaintiffs and counterclaim-defendants Mark Anthony International, SRL (“Mark Anthony”) and
 2 American Vintage Beverage, Inc. (“AVBI”) (collectively, “Plaintiffs”) and defendant and
 3 counterclaimant Jack Daniels Properties, Inc. (“Defendant” or “JDPI”) hereby submit this Joint Case
 4 Management Statement.

5 **1. Jurisdiction and Service**

6 The Court’s jurisdiction over the parties’ claims and counterclaims is based upon 15 U.S.C.
 7 §§ 1114(1), 1121, 1125(a)(1), and 1125(c) (various claims arising under trademark law), 28 U.S.C.
 8 §1331 (federal question) and 28 U.S.C. §1338(a) (any Act of Congress relating to trademarks). No
 9 issues exist regarding subject matter jurisdiction, personal jurisdiction or venue, and no party remains
 10 to be served.

11 **2. Facts**

12 Mark Anthony produces a margarita-flavored ready-to-drink (“RTD”) malt beverage under
 13 the mark CAYMAN JACK. AVBI has been distributing CAYMAN JACK in the United States since
 14 December 2010. JDPI, through its predecessors-in-interest and licensees, has for many years used
 15 the JACK DANIEL’S mark and other JACK-formative marks in connection with whiskey, cordials,
 16 prepared alcoholic cocktails, liqueurs, RTD alcoholic beverages, and other goods and services.

17 On October 16, 2009, Mark Anthony applied to register the CAYMAN JACK mark with the
 18 United States Patent and Trademark Office (“PTO”) in Class 32 for “flavored brewed malt-based
 19 alcoholic beverages in the nature of beer” and in Class 33 for “prepared alcoholic cocktail,” as shown
 20 in App. Serial No. 77/850,939. On March 9, 2010, the PTO approved the CAYMAN JACK
 21 trademark application and published the application in the *Official Gazette of the United States*
 22 *Patent and Trademark Office*. On September 3, 2010, JDPI filed *Jack Daniel's Properties, Inc. v.*
 23 *Mark Anthony International SRL*, Opposition No. 91196371, before the Trademark Trial and Appeal
 24 Board (“TTAB”) opposing registration of Mark Anthony’s trademark application and citing its prior
 25 JACK DANIEL’S and other JACK-formative registrations (the “TTAB Action”). On April 3, 2012,
 26 the parties stipulated to suspend the opposition proceeding pending the resolution of the proceeding
 27 now before the Court.

1 **3. Legal Issues**

2 Mark Anthony and AVBI seek a declaratory judgment that their use of CAYMAN JACK on
3 margarita-flavored RTD malt beverages does not infringe JDPI's JACK DANIEL'S and other JACK-
4 formative marks, and that Mark Anthony's application to register CAYMAN JACK with the United
5 States Patent and Trademark Office should be allowed. JDPI has answered the declaratory judgment
6 complaint, denying the charging allegations, and has counterclaimed for infringement, unfair
7 competition and dilution under the Lanham Act. The primary legal issues involved in this case are
8 therefore expected to include (i) whether Mark Anthony's and AVBI's advertising, distribution and sale
9 of CAYMAN JACK margarita-flavored RTD malt beverages is likely to cause confusion, mistake or
10 deception as to the source of CAYMAN JACK beverages or their affiliation, connection or association
11 with, or sponsorship or approval by, JDPI and its JACK DANIEL'S and JACK-formative marks for
12 whiskey, prepared alcoholic cocktails, liqueurs, and RTD alcoholic beverages, (ii) whether Mark
13 Anthony's and AVBI's advertising, distribution and sale of CAYMAN JACK margarita-flavored RTD
14 malt beverages is likely to cause dilution by blurring of JDPI's JACK DANIEL'S mark, and (iii) whether
15 the PTO should reject JDPI's opposition and allow Mark Anthony's trademark Application Serial No.
16 77/850,939 to proceed to registration, or whether the Court must permit the TTAB to decide what impact
17 a finding by this Court of a likelihood of confusion or of no likelihood of confusion will have on the
18 outcome of the TTAB Action.

19 **4. Motions**

20 No motions have been filed and currently no motions are pending.

21 To the extent that dispositive motions may be appropriate later in the case, the parties have built
22 time for the same into the proposed case schedule (*see* Item No. 17, below).

23 **5. Amendment of Pleadings**

24 At this time, the parties are not aware of any anticipated additions to, or dismissals of, parties,
25 claims, or defenses.
26
27
--

1 **6. Evidence Preservation**

2 The parties have taken appropriate steps to preserve and protect documents and electronically
3 stored information potentially relevant to this dispute from modification or loss.

4 **7. Disclosures**

5 JDPI and Mark Anthony previously exchanged initial disclosures in the TTAB Action and agree
6 that the previous disclosures can be used in this action. Those parties also agree to supplement those
7 initial disclosures to reflect all applicable areas of disclosure under Fed. R. Civ. P. 26(a), on or before
8 July 26, 2012, per the Court's Scheduling Order. AVBI will make its Initial Disclosures pursuant to Fed.
9 R. Civ. P. 26(a), on or before July 26, 2012, per the Court's Scheduling Order.

10 **8. Discovery**

11 As of the submission of this Statement to the Court, no discovery has been taken in this action.
12 However, the parties previously exchanged discovery requests and responses, and produced documents,
13 in the TTAB Action. The parties agree that discovery taken in the TTAB Action can be used in this
14 action as if the requests were promulgated, and the responses issued, in this action (though not counting
15 towards any discovery request limits in this matter). The parties anticipate that additional discovery shall
16 be taken in accordance with the scope and procedures permitted by the Federal Rules of Civil Procedure
17 and the Local Rules of this Court.

18 In accordance with Fed. R. Civ. P. 26(f), the parties propose the following discovery plan:

- 19 (A) The parties will exchange any necessary supplement to their initial disclosures, as
20 provided above, on or before July 26, 2012. The parties agree to exchange written expert
21 and pretrial disclosures according to the schedule set forth in Item No. 17 below.
- 22 (B) Except as may be modified by agreement of the parties or order of the Court, discovery
23 will be needed on all claims and defenses stated in the pleadings, and is expected to
24 encompass at least the following issues (i) Plaintiffs' use of the CAYMAN JACK mark
25 on their margarita-flavored RTD malt beverage, (ii) the extent to which Defendant's
26 JACK DANIEL'S and JACK-formative marks are strong and are widely recognized by
27 the general consuming public of the United States as a designation of source of the goods

or services of Defendant, (iii) the extent to which JDPI's JACK DANIEL'S mark and other JACK-formative marks are already coexisting with other trademarks for beverages containing the word JACK, including through co-existence and settlement agreements including PANAMA JACK and CALICO JACK for rums; CACTUS JACK for tequila; PAPA JAC for alcoholic cocktails; YUKON JACK for liqueur; SCRUMPY JACK for cider; DEADEYE JACK, THIRSTY JACK, BLACK JACK STOUT, JACK RABBIT PALE ALE and JACK'S PUMPKIN SPICE ALE for malt beverages; HONEYJACK for mead and hydromel; and BLACKJACK PASTURE, JUMPIN JACK and BLACKJACK WINES for wines (these issues may involve third-party discovery); (iv) the likelihood of confusion, if any, between the parties' respective marks and products, (v) the likelihood of dilution by blurring, if any, of Defendant's JACK DANIEL'S mark caused by Plaintiffs' use of the CAYMAN JACK mark on their margarita-flavored RTD malt beverage, and (vi) and information relevant to damages and other forms of equitable and legal remedies.

(C) The parties are preparing a Stipulated Protective Order modeled after the Northern District's Stipulated Protective Order for Standard Litigation and intend to submit it to the Court for approval shortly.

(D) At this time, the parties do not propose any changes to the limitations on discovery imposed by the Federal Rules of Civil Procedure or the Civil Local Rules. The parties have agreed, however, that either of them may propose a change at a later time if it deems necessary.

(E) At this time, the parties do not have any other suggested orders that the Court should issue under Fed. R. Civ. P. 26(c) or under Fed. R. Civ. P. 16(b) and (c).

9. Class Actions

This litigation is not a class action.

1 **10. Related Cases**

2 *Mark Anthony International SRL and American Vintage Beverage, Inc. v. Jack Daniel's*
 3 *Properties, Inc.* Case No. 12-cv-00477, United States District Court for the District of Connecticut. This
 4 case, filed on March 28, 2012, is the predecessor to the instant action and concerned substantially the
 5 same parties and issues. A dispute over whether the District of Connecticut could exercise personal
 6 jurisdiction over Defendant prompted Plaintiffs to voluntarily dismiss that case and file the present one
 7 in the Northern District of California (*See* Dkt. 7).

8 *Jack Daniel's Properties, Inc. v. Mark Anthony International SRL*, Opposition No. 91196371
 9 (TTAB). This trademark opposition proceeding, filed September 3, 2010, concerns Mark Anthony's
 10 application to register its CAYMAN JACK mark (App. Serial No. 77/850,939). On April 3, 2012, the
 11 parties stipulated to suspend the opposition proceeding pending the resolution of this proceeding.

12 **11. Relief**

13 Plaintiffs seek a declaratory judgment of non-infringement and an order directing the USPTO to
 14 dismiss the JDPI's Opposition and register the CAYMAN JACK mark. Defendant seeks dismissal of
 15 Plaintiffs' declaratory relief action with prejudice, injunctive relief prohibiting Plaintiffs' use and
 16 registration of the CAYMAN JACK mark and the caymanjack.com domain name, as well as monetary
 17 relief including Defendant's damages, Plaintiffs' profits, and Defendant's attorneys' fees and litigation
 18 costs (should the case be deemed exceptional), as provided for in Section 35 of the Lanham Act, 15
 19 U.S.C. § 1117.

20 **12. Settlement and ADR**

21 The parties have engaged in settlement discussions. However the discussions have not yet
 22 resulted in a final resolution of the dispute.

23 Plaintiffs request that a settlement conference be held after discovery is concluded before
 24 Magistrate Judge Joseph C. Spero, subject to his availability. Given that settlement discussions have
 25 been ongoing since May 2010 and the parties have been unable to reach agreement, Plaintiffs believe
 26 that mediation or a settlement conference will be unproductive at this time. Rather, Plaintiffs believe the
 27 best prospect for settling this case will exist after they have been able to take the depositions of

1 Defendant's witnesses and after the parties exchange their expert reports (since consumer perception
2 surveys showing confusion or the lack thereof can be critical evidence in infringement cases like this
3 one).

4 Defendant believes that either private mediation or a Court-sponsored early settlement
5 conference within the next ninety (90) days will be productive toward achieving a final settlement. This
6 is because the parties have already exchanged settlement proposals, circulated a draft settlement
7 agreement, and continue to negotiate the provisions that divide the parties. Before the parties commit to
8 the significant expense and distraction associated with months of discovery, Defendant believes it would
9 be worthwhile to work with a neutral to try to resolve the parties' remaining differences. Defendant
10 requests that should the Court order an early settlement conference, that such conference be held before
11 Magistrate Judge Joseph C. Spero, subject to his availability.

12 **13. Consent to Magistrate Judge for All Purposes**

13 The parties do not both consent to proceed before a Magistrate Judge for all purposes.

14 **14. Other References**

15 This case is not suitable for reference to binding arbitration, a special master, or the Judicial Panel
16 on Multidistrict Litigation.

17 **15. Narrowing of Issues**

18 At this time, the parties are not aware of any issues in this case that can be narrowed by
19 agreement or by motion. The parties will re-visit whether they can stipulate to some facts and/or legal
20 issues prior to trial.

21 **16. Expedited Schedule**

22 The parties do not believe that this case could be handled on an expedited basis with streamlined
23 procedures.

24 **17. Scheduling**

25 Plaintiffs propose the following schedule (taking into account that the parties already have
26 engaged in extensive fact discovery in the TTAB Action, and that Defendant has been slow to respond in
27

1 settlement discussions, causing Plaintiffs to believe that a schedule that moves this case along promptly
 2 will be most effective at focusing the parties on whether settlement is appropriate in this case):

- 3 a. Lay discovery cutoff: November 9, 2012 (Friday)
- 4 b. Designation of experts: November 16, 2012 (Friday)
- 5 c. Designation of rebuttal experts: December 17, 2012 (Monday)
- 6 d. Expert discovery cutoff: January 18, 2013 (Friday)
- 7 e. Last day to file dispositive motions: February 1, 2013 (Friday)
- 8 f. Pretrial disclosures: March 1, 2013 (Friday)
- 9 g. Pretrial conference: March 22, 2013 (Friday)
- 10 h. Trial: April 22, 2013 (Monday)

11 Defendant proposes the following due dates (taking into account that the prior discovery taken in
 12 the TTAB Action concerned only the registrability of the CAYMAN JACK mark and not the broader,
 13 use-related issues critical here and the extensive third-party discovery contemplated by Plaintiffs in
 14 Section 8(B)(iii) of this Statement, and to allow the parties to participate in an early ADR process and
 15 continue to negotiate a settlement):

- 16 a. Lay discovery cutoff: January 31, 2013 (Thursday).
- 17 b. Designation of experts: February 15, 2013 (Friday).
- 18 c. Designation of rebuttal experts: March 1, 2013 (Friday).
- 19 d. Expert discovery cutoff: March 15, 2013 (Friday).
- 20 e. Last day to file dispositive motions: March 29, 2013 (Friday).
- 21 f. Pretrial disclosures: April 26, 2013 (Friday).
- 22 g. Pretrial conference: May 9, 2013 (Thursday).
- 23 h. Trial: June 10, 2013 (Monday).

24 **18. Trial**

25 The parties anticipate a one-week trial. No party has demanded a jury trial.
 26
 27
 --

1 **19. Disclosure of Non-Party Interested Entities or Persons**

2 The parties have each filed their Certification of Interested Entities or Persons required by Civil
3 Local Rule 3-16.

4 Plaintiffs' Statement: Pursuant to Civil L.R. 3-16, Plaintiffs Mark Anthony International, SRL
5 and American Vintage Beverage, Inc. hereby certify that the following listed persons, associations of
6 persons, firms, partnerships, corporations (including parent corporations) or other entities (i) have a
7 financial interest in the subject matter in controversy or in a party to the proceeding, or (ii) have a non-
8 financial interest in that subject matter or in a party that could be substantially affected by the outcome of
9 this proceeding:

10 Anthony von Mandl – indirect shareholder of both plaintiffs.

11 Pelecanus Holdings Ltd. – indirect parent of both plaintiffs.

12 Defendant's Statement: Pursuant to Civil L.R. 3-16, the undersigned certifies that the following
13 listed persons, associations of persons, firms, partnerships, corporations (including parent corporations)
14 or other entities (i) have a financial interest in the subject matter in controversy or in a party to the
15 proceeding, or (ii) have a non-financial interest in that subject matter or in a party that could be
16 substantially affected by the outcome of this proceeding:

17 Jack Daniel's Properties, Inc. is a wholly-owned subsidiary of Brown-Forman Corporation, a
18 publicly-traded corporation.

19 **20. Other Matters**

20 The parties have no other matters to address in this paper.

21 ///

22 ///

23
24
25
26
27
--

1 Dated: July 26, 2012

2 Respectfully submitted,

3 By: /s/
Robert N. Phillips

4 ROBERT N. PHILLIPS (SBN 120970)
5 REED SMITH LLP
6 101 Second Street, Suite 1800
San Francisco, CA 94105
7 Telephone: (415) 543-8700
Facsimile: (415) 391-8269
8 Email: robphillips@reedsmith.com

9 And
10 DAVID H. BERNSTEIN (*pro hac vice*)
11 JYOTIN HAMID (*pro hac vice*)
12 ASHLEY E. KELLY (*pro hac vice*)
DEBEVOISE & PLIMPTON
13 919 Third Avenue
New York, NY 10022
14 Telephone: (212) 909-6696
Facsimile: (212) 521-7696
Emails: dhbernstein@debevoise.com
15 jhamid@debevoise.com
aekelly@debevoise.com

16 Attorneys for Plaintiffs and Counterclaim-
17 Defendants MARK ANTHONY
18 INTERNATIONAL, SRL and AMERICAN
19 VINTAGE BEVERAGE, INC.

Respectfully submitted,

By: /s/
Christopher C. Larkin

CHRISTOPHER C. LARKIN (SBN 119950)
SEYFARTH SHAW LLP
2029 Century Park East, Suite 3500
Los Angeles, CA 90067-3021
Telephone: (310) 277-7200
Facsimile: (310) 201-5219
Email: clarkin@seyfarth.com

And
D. PETER HARVEY (SBN 55712)
MATTHEW A. STRATTON (SBN 254080)
HARVEY SISKIND LLP
Four Embarcadero Center, 39th Floor
San Francisco, CA 94111
Telephone: (415) 354-0100
Facsimile: (415) 391-7124
Emails: pharvey@harveysiskind.com
mstratton@harveysiskind.com

Attorneys for Defendant and Counterclaim-
Plaintiff JACK DANIELS PROPERTIES,
INC

20 I, D. Peter Harvey, am the ECF User whose identification and password are being used to file
21 this document. Pursuant to General Order 45.X.B, I hereby attest that counsel for all parties
22 concurred in this filing.

23 /s/
24 D. Peter Harvey